REMARKS

Claims 1-29 are pending in this application. Applicant respectfully requests reconsideration of claims 1-29.

The Rejections

Claims 1-29 have been rejected under 35 U.S.C. §102(b) as being anticipated by Geller et al. (U.S. Patent No. 5,844,554).

Claims 1-25

The Examiner is directed to Amendment B for a discussion of the patentability of these claims with respect to Geller et al.

In paper #17 the Examiner states, with reference to the teaching of Geller et al., that "such parameters and constraints which are utilized to define the rules for the configuration, wherein the parameters contain the save, calculate, compare and the constraints govern the retrieval and calculation and the 'UsedWhen' property" is read on by the claim limitations of "modifying of the results by detecting and eliminating incompatibilities caused solely by bounceback behavior" (page 4 first full paragraph). Applicant fails to discern how the Examiner has equated the two. More particularly, Applicant cannot discern from the above whether utilizing parameters and constraints to define configuration rules in Geller et al. is being equated to the limitation of detecting incompatibilities caused solely by bounceback behavior, or the limitation of modifying the results by eliminating those incompatibilities, or both. Neither can Applicant discern how the "save, calculate, compare" attributes contained by the parameters of Geller et al., nor the "retrieval and calculation and the 'UsedWhen' property" governed by the constraints of Geller et al., relate to the claim limitations. Applicant has read and considered the sections of Geller et al. cited by the Examiner in the Response to Arguments section (pages 2-4) and finds that the Examiner has generally correctly restated the teachings of Geller et al. provided in those sections, but finds nothing in the Examiner's response that helps illuminate how the Examiner is equating those teachings with the claim language.

In paper #17 the Examiner goes on to state that "[t]hese claims were given the broadest reasonable interpretation in an effort to reduce the possibility that these claims, once issued, will be interpreted more broadly than is justified" (page 4 second full paragraph citing *In re Prater*). Applicant believes that the Examiner has actually combined two citations found in MPEP 2111 into the one above that is credited solely to *In re Prater*. Specifically, MPEP 2111 provides that "[d]uring patent examination, the pending claims must be 'given their broadest reasonable interpretation consistent with the specification.' *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)"

Applicant notes that the Examiner omitted from the quotation from *In re Hyatt* the concept that the broadest reasonable interpretation must be "consistent with the specification." The same concept, namely that "[o]ffice personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)" is found in MPEP 2106(C). The same section of the MPEP goes on to state that "[d]uring patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process" (citing *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Moreover, "[b]efore final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; ... Switching from one subject matter to another in the claims presented by applicant in successive amendments, **or from one set of references to**

another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection" (MPEP 706.07, emphasis added).

Applicant contends that the interpretation given to the claim language by the Examiner is unreasonable precisely because it is not consistent with the specification. Further, Applicant has not been able to discern from the record exactly what interpretation the Examiner has been giving to the claim language. Applicant notes that Amendment A set forth a definition of "bounceback behavior" that was fully supported by the specification, and in view of this definition and supporting arguments the Examiner withdrew the rejections of the claims over the Gupta et al. reference and switched to the Geller et al. reference even though the claims were of substantially the same subject matter. It is unclear to the Applicant why the arguments presented in Amendment A were sufficient to overcome Gupta et al. but do not overcome Geller et al.

In short, Applicant fails to see that a clear issue has been developed between the Examiner and the Applicant as required for a proper final rejection. Applicant wishes to bring the prosecution to as speedy conclusion as possible and avoid the Appeal process, but has been repeatedly unable to resolve the position of the Examiner. Applicant respectfully requests that the Examiner identify any ambiguities in the claim language, so that the scope and breadth of language can be properly explored and clarification imposed so that Applicant can fashion claims that are precise, clear, correct, and unambiguous. Applicant reminds the Examiner that "[t]he examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal" and that "[t]he applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application" (MPEP 706.07).

Accordingly, Applicant respectfully requests the cooperation of the Examiner in removing any uncertainties of claim scope by reopening the prosecution of this application and providing the Examiner's interpretation of the meaning of the terms of

the claims, in particular "propagating the constraints," "a result that identifies incompatibilities," and "bounceback behavior" so that at least a clear issue can be developed, and hopefully, resolved.

In addition to the above request, Applicant offers the following comparison of Geller et al. to the present disclosure. Bounceback behavior is described in the specification by way of example (paragraphs 0005 and 0006) involving the configuration of a computer system. In the example, a set of constraints exists between processors and disk drives such that a 500 MHz processor is only compatible with 10 and 20 Gbyte disk drives, and a 700 MHz processor is only compatible with a 30 Gbyte disk drive. When the 500 MHz processor is selected in the example, constraint propagation causes the 30 Gbyte to be eliminated, and the elimination of the 30 Gbyte disk drive further causes the 700 MHz processor to be eliminated. *Thus, bounceback behavior occurs where constraint propagation causes non-selected domain members of a variable to be eliminated in creating a result because another domain member of the same variable has been selected.*

Geller et al. provides a similar example with reference to configuring an automobile, which is cited to by the Examiner (pages 2-3). In this example a user that selects the Gluon product line is provided, on the Sound tab, with the options of "Standard" or "Electronic AM/FM Stereo/Cassette." However, if the user selects the Meson product line then the Sound tab no longer provides the "Electronic AM/FM Stereo/Cassette" option. Applicant submits that this example teaches at best constraint propagation without bounceback detection or incompatibility elimination.

Consider an extension of this example wherein three car models are offered, the Gluon, the Meson, and the Hadron. The Gluon is compatible with either the "Standard" or the "Electronic" stereo, the Meson is compatible with only the "Standard" stereo, and the Hadron is compatible with only the "Electronic" stereo. In this example, if a user were to select the Hadron, constraint propagation would first remove the "Standard" stereo since the Hadron is only compatible with the "Electronic" stereo. Constraint propagation would next remove the Meson option since it is only compatible with the

"Standard" stereo. Thus, due to this bounceback behavior, the user is suddenly left with the choice of the Hadron or the Gluon but not the Meson.

The ability to recognize that the removal of the Meson occurred due to constraint propagation constitutes bounceback detection. Restoring the choice of the Meson along side the Hadron and Gluon constitutes elimination of an incompatibility. In the example provided by Geller et al., removing an incompatible stereo when a product line is selected is an example of constraint propagation, since the constraint has been propagated between variables, however, simply removing some or all other product line options when one product line is selected is merely the application of a rule. Applicant hopes that the Examiner finds these examples useful.

All pending claims are allowable and Applicant respectfully requests a Notice of Allowance from the Examiner. Should the Examiner have questions, the Applicant's undersigned attorney may be reached at the number provided.

Respectfully submitted,

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